REMARKS

Examiner Luebke was contacted on November 28, 2005 and indicated that she is no longer assigned to this case, and that the case has been transferred to Examiner Truc Nguyen. In a phone conversation on November 29, 2005, Examiner Nguyen suggested filing an after final response rather than a notice of appeal and indicated that he would review this after final response.

New Matter objections and rejections under
35 U.S.C. § 132 and 35 U.S.C. § 112

The previous Examiner objected to the amendment filed September 13, 2004 as adding new matter. In particular, the previous Examiner indicated that "the added material which is not supported by the original disclosure is the requirement that the claimed memory card is compatible with two different structural receptacles or card formats." However, the Examiner did indicate that "Applicant's arguments are convincing with regard with regard to electronic or media formats." It appears that the previous Examiner failed to appreciate that format of the card and its receptacle is structural, among other things.

It is kindly asserted that no new matter was introduced in the previous responses. Contrary to the Examiner's assertion, the specification, as filed, teaches and contemplates a memory card "compatible with two different receptacles or formats."

The specification explicitly teaches a removable memory card that is used in receptacles of host electronic systems or devices. These are devices such as cellular telephones, music players and other personal electronic equipment. Two specific examples of different receptacles or formats are taught: the MMC card and its associated receptacle, and the SD card and its associated receptacle. The relevant portions are shown here for convenience:

> BACKGROUND OF THE INVENTION
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> This invention relates to a small card containing digital memory, such as a non-volatile flash EEPROM system, having exposed surface electrical contacts that allow easy connection to and removal from a **receptacle of a host electronic system or device**, particularly portable devices, in order to provide removable electrical connection between the system or device and the memory within the card through the exposed surface contacts of the card.

> Small memory cards are increasing in popularity for use in small hand held devices such as cellular telephones, music players and other personal electronic equipment. Memory cards are being made smaller for such applications while the size of their individual external surface electrical contacts are not being reduced in size to any significant degree. This presents a challenge to the design and packaging of such memory cards. In a specific example, an existing commercial Multi-Media Card (MMC) product has been manufactured and sold for a time. The MMC has seven surface contacts extending across a short edge of the rectangular card that also includes a cut-off corner. Evolving applications for this type of memory card have made it necessary to add several external contacts without increasing the size of the card.
>
> SUMMARY OF THE INVENTION
>
> This has been accomplished by increasing the number of contacts of the row of contacts used on the MMC product while maintaining the position of the row along the short edge of the rectangularly shaped card. This maintains a degree of compatibility between the MMC product and the new card, known as a SD Card product. In order to increase the number of contacts, two contacts are positioned in the space previously occupied by one and another contact is positioned at the cut off corner and set back from the card edge a distance that is greater than other contacts of the row.

Application Pages 1-2 (emphasis added).

Thus, the application explicitly teaches that the positioning of the contacts of the present invention is compatible with both MMC products and SD card products. The memory cards (products) are also explicitly taught "to allow easy connection to and removal from a **receptacle of a host electronic system or device.**" At the time of the invention, as is taught by the application, it was well known that a host device, for example, a digital camera, had a receptacle designed to accept a specific type or format of memory card, for example an MMC card. The slot or receptacle of the camera is structural and was known to have contacts equal in number to those of the card, and the contacts were known to be in the proper location in the receptacle to establish electrical connection between the contacts of the card and the receptacle of the camera.

In addition to the explicit teachings of the specification, the specification also inherently teaches and discloses to one of ordinary skill in the art a memory card "compatible with two different receptacles or formats" because one of ordinary skill in the art would understand, having read at least the above excerpted portions of the specification, that the card is taught is necessarily compatible with both an SD and an MMC receptacle.

Therefore, claims 5-14 are supported by the specification, as filed, and allowance of these claims is requested.

Thus, it is submitted that new matter has not been added in any of the prior responses, and that the application fully complies with the written description requirement of 35 U.S.C. § 112, first paragraph.

The Examiner has also indicated that indefinite under § 112 because "'the means for contacting the memory card' must be part of the device, not the memory card to which the claims are directed." This is incorrect. Both the memory card, and the device it works with can both comprise means for contacting the memory card. This is because the contact between the card and the device is mutual.

Therefore, it is submitted that all pending claims are in condition for allowance and fully in compliance with § 112.

Rejections under 35 U.S.C. § 102

Claims 5-7 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,333,854 to Sasaoka et al. ("Sasaoka")

The Examiner has contended that Sasaoka teaches every element of claims 5-7. The pertinent portion of claim 5 is as follows:

"a first group of rectangularly shaped recesses formed in a row extending along one of said adjacent straight edges, said group containing electrical contacts at the bottom of the recesses, said group compatible with a first type of memory card receptacle; and

a second group of one or more recesses containing one or more electrical contacts,

said first and second group of contacts together compatible with a second type of memory card receptacle" (emphasis added).

Sasaoka does not teach these limitations, including compatibility with different receptacles, nor has the Examiner pointed out any specific teachings of these limitations within Sasaoka.

The previous Examiner in the last Office Action has stated that a "card is compatible with any and all receptacles that are intended to be compatible with it. However, this compatibility does not impose an[y] explicit or implicit limitations on the card itself." June 1 Office action at pages 3-4. This is simply incorrect. Compatibility with a receptacle of a specific type does

impose limitations on the card itself. The design of the card, in terms of the structural form factor, contact structure, and signal or communications protocol, all must be tailored to the receptacle and type of card it is meant to receive and interact with.

If there is any question about this, one need only try and insert an SD card into the receptacle of a Sony digital camera designed to use a Memory Stick. It simply will not fit in the receptacle and will not work.

Thus, Sasaoka does not teach the limitations of independent claim 5 and does not anticipate claim 5.

Dependent claim 6 further recites that "the first receptacle is an MMC card receptacle." Again, Sasaoka does not teach this limitation. In addition to not teaching the limitations of independent claim 5, for all the reasons discussed above, Sasaoka does not teach anything about the MMC card structure. In fact, anything that Sasaoka *may* teach about a memory card contact structure appears to be that of the Memory Stick format of the Sony Corporation. The Memory Stick format is different from the MMC card format, as can be seen in the various MMC card standards contained in the Information Disclosure Statement of record in the present application, and as is well known among those of ordinary skill in the art.

Thus, Sasaoka does not teach the limitations of dependent claim 6 and does not anticipate claim 6.

The pertinent part of claim 7 recites:

"said electrical contacts are positioned in a pattern according to a multi-media card (MMC) standard, a single electrical contact being included in each of said recesses, and

an additional recess having a contact therein is provided,

whereby the memory card remains compatible with the multi-media card (MMC) with the additional recess and whereby the additional recess provides compatibility with an additional memory card standard."

Sasaoka does not teach any of these claim recitations, for the reasons discussed above and in the previous responses.

Therefore, it is asserted that claims 5-7 are not anticipated by Sasaoka, and allowance of these claims is kindly requested.

Claims 8, 9 and 10, 11, 12 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,885,482 to Sharp et al. ("Sharp")

The previous Examiner again rejected all of the above numbered claims as being anticipated by Sharp in the June 1 Office Action. On page 4 of the action, the Examiner stated that "Applicant argues that Sharp is not a memory card as claimed since it is too large. However, the size is not claimed." This is a mischaracterization of Applicant's previous arguments, a portion of which are reproduced below.

> Sharp is not directed towards a memory card and does not teach a memory card. Instead, Sharp teaches a circuit board for use with two different interface standards of different computer systems. Abstract. Sharp is concerned with the circuit boards for use in a personal computer, such as an IBM computer with PS/2 interface standard. Sharp at Col. 3 lines 55-65.

While the size of the circuit board in Sharp was discussed, the purpose was to indicate that Sharp would not be recognized by one of skill in the art as teaching a memory card.

Furthermore, even if Sharp does teach a memory card, it does not teach the specific limitations of the claims.

For example, Sharp does not teach all the limitations of claim 8. Claim 8 is reproduced below.

8. A flat rectangularly shaped memory card comprising:

a card body with a contact structure compatible for use in a first electronic device designed to utilize a first number of contacts of the contact structure,

said contact structure compatible for use in a second electronic device designed to use a second number of contacts of the contact structure wherein the first number is different than the second number,

said contact structure allowing said memory card to be backwards compatible with the first electronic device while also allowing said memory card to be used with the second electronic device. (emphasis added)

For example, Sharp does not teach all the limitations of claim 9. Claim 9 is reproduced below.

9. A memory card comprising:

means for contacting the memory card in order to transfer signals between the memory card and an electronic device,

said means for contacting configured to make contact with a first device compatible for use with a first memory card having a first structural format,

said means for contacting configured to make contact with a second device compatible for use with a second memory card having a second structural format,

said first structural format being different than said second structural format. (emphasis added)

As another example, claim 14 succinctly recites this novel design as specifically implemented in the preferred embodiment: "a card body with a contact structure compatible with both MMC card receptacles and SD card receptacles."

While claims 8, 9, and 14 were discussed as an example, all of claims 8, 9, 10, 11, 12, and 14 are novel based upon the unique combinations of each of the claims, which can generally speaking be understood based upon the arguments above.

Therefore, Sharp cannot anticipate any of the pending claims, and it asserted that all the pending claims are in condition for allowance, which is kindly requested.

Rejections under 35 U.S.C. § 103

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,885,482 to Sharp et al. ("Sharp")

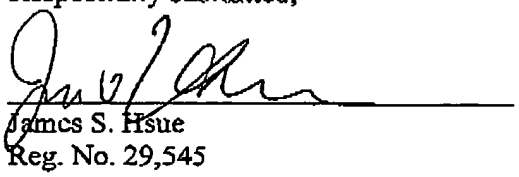
Again, as discussed above, Sharp is not directed towards a memory card, does not teach a memory card, and does not teach the specific limitations of the pending claims. Instead, Sharp teaches a circuit board for use with two different interface standards of different computer systems. Abstract. Sharp is concerned with the circuit boards for use in a personal computer, such as an IBM computer with PS/2 interface standard. Sharp at Col. 3 lines 55-65. This is not relevant to the specific recitations in claim 13 related to a memory card, and certainly does not teach any of those recitations.

Therefore, Sharp cannot anticipate or render obvious any of the pending claims, and it asserted that all the pending claims are in condition for allowance, which is kindly requested.

Conclusion

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner has any further matters that need to be resolved, a telephone call to the undersigned attorney at 415-318-1160 would be appreciated.

Respectfully submitted,



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